

## REMARKS

IDS is being concurrently submitted herewith listing all references cited in the International Search report.

The specification has been objected to because of minor informalities and use of Trademarks. Applicants have amended the specification in good-faith in accordance with the Examiner's kind suggestion. Accordingly, applicants respectfully request that the Examiner withdraw his objections to the specifications.

Abstract of the disclosure has been objected to because of minor informalities. Applicant has amended the abstract of the disclosure in good-faith in accordance with the Examiner's kind suggestion. Accordingly, applicants respectfully request that the Examiner withdraw his objections to the abstract of the disclosure.

Drawings have been objected to because they are not fully translated. Replacement sheets of the drawings are submitted hereto that are fully translated in compliance with 37 C.F.R. § 1.121(d). Accordingly, applicants respectfully request that the objections to the drawings be withdrawn.

Claims 31-60 have been rejected under 35 U.S.C. § 101 as being allegedly directed to a non-statutory subject matter. Applicants have canceled and rewritten claims 31-60 as new claims computer readable medium claims 61-90 incorporating the Examiner's kind suggestions and in conformance with 35 U.S.C. § 101. Accordingly, applicants respectfully requests that the § 101 rejection be withdrawn.

Claims 35-36, 38-49, 54 and 55 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant have canceled and rewritten claims 35-36, 38-49, 54 and 55 as new computer readable medium claims 65-66, 68-79 and 85 incorporating the Examiner's kind suggestions and in conformance with 35 U.S.C. § 112. Accordingly, applicants respectfully requests that the § 112 rejection be withdrawn.

Claims 31-37, 52, 55, 56 and 58-60 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over US published patent application 2002/0038350 to

Lambert et al. (“Lambert”) in view of International publication number WO 01/02978 to Koenig (“Koenig”). Claims 38-40 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lambert and Koenig further in view of International publication number WO 01/46856 to Steele et al. (“Steele”). Claims 53 and 54 rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lambert and Koenig further in view of Examiner’s notice. Claims 31-40, 52-56 and 58-60 have been canceled and replaced with computer readable medium claims 61-70, 82-86, 88-90 to overcome the § 101 rejection. Accordingly, applicants have assumed that this rejection applies equally to new claims 61-70, 82-86, 88-90.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. Here, the Examiner will fail to establish a *prima facie* case of obviousness because the combination of Lambert and Koenig does not teach or suggest all the claim limitations of new claims 61-67, 82, 85, 86, 88-90.

Applicants respectfully submit that Lambert “relates generally to the enhancement of Web page delivery. More specifically, the invention employs techniques in identifying visitors, both humans and search engine spiders, and appropriately redirecting them to specific Universal Resource Locators” (emphasis added) (Lambert, paragraph 2). Whereas, the present invention is directed referencing websites indexed by Internet search tools and providing access to a database using two separate interfaces. One interface for a client managing the website and the other interface for a consultant to reference the website and communicate with the client. In fact, paragraphs 120-127 in

Lambert cited by the Examiner merely describes that “GUI 12 is employed in changing the redirect URL for simple redirects and the specifications for more complex redirections.” Contrary to the Examiner’s assertion, Lambert does not suggest using the GUI to manage the access to a database.

The prior must to be judged based on a full and fair consideration of what art teaches, not by using Applicants invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Applicant’s invention. The Examiner cannot simply change the principle of the operation of the reference or render the reference inoperable for its intended purpose to render the claims unpatentable. There is no objective teaching in Lambert to reconstruct Lambert in a manner suggested by the Examiner where the GUI is used to manage the access to a database. Accordingly, it is submitted that the Examiner has succumbed to the lure of prohibited hindsight reconstruction.

Additionally, as admitted by the Examiner, Lambert does not teach or suggest using two separate interfaces to manage the access to the database between two different kinds of user. To cure this deficiency, the Examiner turns to Koenig. However, Koenig does not even remotely relate to referencing websites indexed by Internet search tools. Koenig relates to an Internet-based matching service for matching an expert with a certain expertise with a customer requiring someone with such expertise. Accordingly, page 9 in Koenig cited by the Examiner merely describes an expert entering her qualifications and time availability into an expert database and a customer entering her requirements into a customer database. The contents of the expert and customer databases are compared for a match and if there is a match, a matching dataset lists which experts are a match for which customers. Accordingly, contrary to the Examiner’s assertion, Koenig, at best, describes a customer interface to access a customer database and an expert interface to access an expert database. Even assuming *arguendo* that Koenig relates to the present invention, there is simply no teaching or suggestion in

Koenig of utilizing two separate interfaces to manage the access to a single database, as required by the claims of the present invention.

Further, as admitted by the Examiner, the combination of Lambert and Koenig does not teach or suggest reading the content of a website coded in HTML and translating it into an XML document. To cure this deficiency, the Examiner turns to Steele. However, Steele does not teach or suggest utilizing two separate interfaces to manage the access to a single database, as required by the claims of the present invention.

“To imbue one of ordinary skill in the art with knowledge of the present invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious effect of hindsight syndrome, wherein that which only the inventor taught is used against the teacher.” W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). In the present case, Even assuming *arguendo* that the combination of Lambert and Koenig and the combination of Lambert, Koenig and Steele are proper, the combinations do not teach or suggest utilizing two separate interfaces to manage the access to a single database, as required by the claims of the present invention.

The prior must to be judged based on a full and fair consideration of what that art teaches, not by using Applicants invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Applicant’s invention. The Examiner cannot simply change the principle of the operation of the reference or render the reference inoperable for its intended purpose to render the claims unpatentable. There is no objective teaching in Koenig to reconstruct Koenig in a manner suggested by the Examiner. Firstly, Koenig relates to Internet-based matching service. Secondly, Koenig describes using one interface to access a first database and a second interface to access a second database. Accordingly, it is submitted that the Examiner has succumbed to the lure of prohibited hindsight reconstruction.

Furthermore, the claimed invention defined by the claims eliminates the shortcomings and disadvantages encountered with the prior art. Specifically, the claimed invention provides a software platform based method for managing access to a database

for managing and referencing websites. None of the cited references are directed to the problem solved by the present invention. It is undeniable that neither Lambert, Koenig nor Steele is even remotely concerned with the problem of providing a software platform based method for managing access to a database for managing and referencing websites. The mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Laskoski, 871 F.3d 115, 117, 10 USPQ2d 1397, 1399 (Fed. Cir. 1989). Absent any disclosure directed to the claimed invention, there is no teaching or motivation for the proposed modification. Since Applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by Woods, the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". Id. at 1962. See also, In re Rinehart, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem of providing a software platform based method for managing access to a database for managing and referencing websites was even recognized by the prior art, there can be no finding that the invention as a whole would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), "an inventive contribution can reside as well in the recognition of a problem as in a solution". It further appears that the conclusion reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that "[a]ppellant having discovered the source of the problem and solved the same . . . he is... entitled to patent protection". Id. at 121. Here, as noted herein, the Examiner's primary reference (Lambert) relates to solving a completely different problem of providing enhanced web page delivery; the Examiner's secondary reference (Koenig) relates to solving yet another completely different problem

of providing Internet-based matching service; and the Examiner's tertiary reference (Steele) relates to solving still yet another completely different problem of providing generating an index of data accessible from a server.

Therefore, the Examiner cannot establish a *prima facie* case of obviousness because these references independently or in combination thereof fails to solve the problem of providing a software platform based method for managing access to a database for managing and referencing websites. Accordingly, Applicant respectfully requests the allowance of new claims 61-70, 82-86, 88-90.

Applicants acknowledge with appreciation that claims 41-51 and 57 would be allowed if applicant resolves the issues with respect to § 101 and § 112. In accordance with the Examiner's kind suggestion, claims 41-51 and 57 have been canceled and rewritten as new computer readable medium claims 71-81 and 87 to overcome the § 101 and § 112 rejections, as noted herein.

Therefore, applicants believe all of the pending claims 61-90 are now in condition for allowance.

The Commissioner is hereby authorized to deduct the extension of time fee from Deposit Account No. 50-6024.

Respectfully submitted,

**FULBRIGHT & JAWORSKI L.L.P.**

By



C. Andrew Im

Reg. No. 40,657

Attorney for Applicant

666 Fifth Avenue  
New York, New York 10103  
(212) 318-3000